

## REMARKS

Reconsideration and allowance are respectfully requested. Claims 1-41 are now pending. By this Amendment, new claim 41 is added.

### The Claim Rejections

Claims 1-7, 10-12, 16-26, 29-31, and 35-40 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,347,295 to Agulnick et al. ("Agulnick"). Dependent claims 14 and 33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Agulnick in view of U.S. Patent No. 5,502,803 to Yoshida et al. ("Yoshida"). Dependent claims 15 and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Agulnick in view of U.S. Patent No. 6,307,956 to Black et al. ("Black"). Dependent claims 8, 9, 27, and 28 are rejected 35 U.S.C. § 103(a) as being unpatentable over Agulnick in view of U.S. Patent No. 6,535,897 to Altman et al. ("Altman"). Dependent claims 13 and 32 are rejected 35 U.S.C. § 103(a) as being unpatentable over Agulnick.

### Response

Applicants would like to summarize two important arguments:

- Although Agulnick senses the proximity of a stylus to a computer screen, gestures are made on the computer screen of Agulnick, not in-air.
- Agulnick does not teach or suggest the claimed moving buffer.

Independent claim 39 recites, *inter alia*, detecting a motion of a stylus with respect to an electronic writing surface, the stylus not physically contacting the electronic writing surface during the motion; and determining, responsive to the motion stopping, whether the motion of

the stylus corresponds to a first motion from a plurality of predefined motions. Thus, such stylus motion is made “in-air,” as opposed to being made on the electronic writing surface itself.

Agulnick discloses proximity sensing of the approach of a stylus tip to a computer screen, and then sensing gestural commands on the screen from stylus movement. Agulnick, abstract. The proximity of the stylus to the computer screen’s front surface is used to anticipate and terminate stylus gestures drawn on the screen. Agulnick, col. 3, lns. 41-43; col. 13, lns. 6-11; and col. 17, lns. 56-58. Then, once the stylus touches the screen, gestures are drawn on the screen itself. Agulnick, col. 7, lns. 5-6, col. 8, lns. 26-27 and 57-61; col. 13, lns. 6-11.

Thus, in Agulnick, there are two types of stylus movement that can be sensed. First, there is the approach or removal of the stylus to or from the screen. Agulnick, col. 8, lns. 54-55 and 59-61. However, Agulnick does not teach or suggest that such approach or removal is a motion that is determined, “responsive to the motion stopping, whether the motion of the stylus corresponds to a first motion from a plurality of predefined motions,” as recited in claim 39.

The second type of stylus motion disclosed in Agulnick is the gestural command made on the screen. Agulnick, col. 8, lns. 26-27 and 57-58. However, in Agulnick the gestural commands are stylus movements made on the screen itself. In contrast, the stylus motion in claim 39 is made “when the stylus is not physically contacting the electronic writing surface during the motion,” as recited in claim 39.

Independent claim 1 recites, inter alia, recording positional information of a digitizing pen with respect to a surface of a digitizing writing surface when the digitizing pen is determined to not be in contact with the digitizing writing surface, as well as determining whether the positional information corresponds to a predetermined in-air gesture that can be made with the digitizing pen. Claim 1 further recites that a predetermined amount of positional information

spanning a predetermined amount of time is recorded while the digitizing pen is in motion and not in contact with the digitizing writing surface. Claim 1 is therefore also allowable over Agulnick for at least similar reasons as those set forth above with regard to claim 39, and further in view of the differing recitations therein.

Moreover, independent claim 1 also recites recording the positional information of the digitizing pen within a moving buffer. Applicants agree with the Office Action's statement that a moving buffer is "not shown" in Agulnick. Office Action, page 2 (near bottom). Applicants would therefore appreciate the Examiner indicating exactly where Agulnick allegedly discloses a moving buffer. In any event, Applicants respectfully submit that Agulnick fails to teach or suggest the claimed moving buffer.

Independent claim 20 is also allowable over Agulnick for at least similar reasons as those set forth above with regard to claim 1, and further in view of the differing recitations therein.

Claims 2-19, which depend from claim 1, claims 21-38, which depend from claim 20, and claim 40, which depends from claim 39, are also allowable over Agulnick for at least those reasons set forth above with regard to their respective independent claims, and further in view of the additional features recited therein. Moreover, none of the other asserted references (i.e., Yoshida, Black, and Altman), either alone or in combination with Agulnick, teach or suggest the claimed invention. Without conceding the propriety of the proposed combinations of references, claims 14 and 33 are thus allowable over Agulnick in view of Yoshida, claims 15 and 34 are allowable over Agulnick in view of Black, and claims 8, 9, 27, and 28 are allowable over Agulnick in view of Altman.

Specifically with regard to dependent claims 13 and 32, the Office Action alleges that determining whether positional information recorded in the moving buffer corresponds to a

predetermined in-air gesture is based on a detected motion speed is an obvious modification of Agulnick. However, the Office Action has attempted to improperly piece together the invention using Applicant's own disclosure as a roadmap.

On page 7 of the Office Action, the motivation to modify Agulnick to perform as recited in claims 13 and 32 is stated as follows: "it would have been obvious to obtain the predetermined in-air gesture is based on a detected motion speed in order to provide easy and quick access to the system functionality." The problem with this reasoning is that the only motivating source one could have looked to decide that quick and easy access would result from modifying Agulnick to operate precisely as claimed is Applicants' own specification. The alleged motivation is thus a phantom "motivation" that in actuality is improper hindsight. The question really is: was there a motivation in the prior art that would have led one skilled in the art to have modified Agulnick in the exact manner proposed? Instead of meeting its *prima facie* burden of showing evidence that such a motivation existed in the prior art, the Office Action has made a conclusory determination of obviousness.

In fact, the U.S. Court of Appeals for the Federal Circuit recently vacated a decision of the Board of Patent Appeals and Interferences of the USPTO rejecting claims of the applicant based on a conclusory determination of obviousness. *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002). According to the Federal Circuit, the standard requires "[w]hen patentability turns on the question of obviousness, the search and analysis of the prior art includes evidence relevant to the finding of whether there is teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness"(underlining added). *Id.* at 61 USPQ2d 1433. The Federal Circuit went on to say that "[o]ur case law makes clear that the best defense against the subtle, but powerful attraction of hindsight based obviousness analysis is a rigorous

application of the requirement of a showing of the teaching or motivation to combine prior art references.” *In re Lee*, 61 USPQ2d at 1433 (quoting, *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)).

Also as held by the U.S. Court of Appeals for the Federal Circuit, “[i]t is impermissible to use the claimed invention as an *instruction manual* or “*template*” to piece together the teaching of the prior art ... [o]ne cannot use hindsight construction to pick and choose among isolated disclosures ... to deprecate the claimed invention.” *In re Fritch*, 972 F.2d 1260, 1266 (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) (emphasis added)). Yet such picking and choosing is exactly what the Office Action is attempting to do, but even worse; the prior art does not even teach the pieces of the claimed invention.


#### **New Claim 41**

New independent claim 41 is also allowable. None of the art of record, either alone or in any combination, teaches or suggests, in a computing system, a method for receiving a command input, comprising steps of detecting a motion of a stylus with respect to an electronic writing surface, the stylus not physically contacting the electronic writing surface during the motion; detecting an end of motion event after the step of detecting the motion; determining, responsive to the end of motion event, whether the motion of the stylus corresponds to a first motion from a plurality of predefined motions; and performing a function associated with the first motion in response to the motion of the stylus corresponding to the first motion.

**Conclusion**

All rejections having been addressed, it is submitted that the present application is in condition for allowance, and a notice to that effect is respectfully requested. Should the Examiner feel that a telephone conference would expedite prosecution, she is invited to contact the undersigned at the number below.

Respectfully submitted,

By:   
Jordan N. Bodner  
Registration No. 42,338

BANNER & WITCOFF, LTD.  
1001 G Street, N.W.  
Eleventh Floor  
Washington, D.C. 20001  
Telephone: (202) 824-3150  
Facsimile: (202) 824-3150

Date: March 12, 2004